

NATHAN

Serial No. 09/357,764

Amendment dated February 3, 2004

Response to Office Action dated October 3, 2003

REMARKS

Upon entry of this amendment, claims 11-16 are pending. By the present amendment, claim 11 has been amended for clarity and new claim 16 has been added. Favorable reconsideration of the application is respectfully requested.

The rejection of claims 11-13 and 15 under 35 U.S.C. §103(a) over Martin et al. (U.S. Patent No. 5,355,302, hereinafter "Martin") in view of Cohen (U.S. Patent No. 6,198,408) is respectfully traversed. Without acquiescing in the rejection, it is noted that claim 11 has been amended for clarity. Accordingly, the rejection will be discussed with respect to the amended claim.

Martin is directed to a system for managing a plurality of computer jukeboxes. Among other things, Martin generally discloses a system including a number of computer jukeboxes that are in communication with a central station that can be used to download musical recording data to the jukeboxes. The jukeboxes are also equipped with a user interface that enables patrons to communicate with a processor means of the computer jukebox. Contrary to the allegation in the Office Action, there is no teaching whatsoever in Martin of a remote control device. The Office Action points to the keyboard 123 of Martin as a teaching of a remote control. This allegation is simply incorrect. The keyboard 123 of Martin, as illustrated in Figure 1, is integral to the computer jukebox. There is no teaching or suggestion anywhere in Martin of the keyboard being a "remote" control device. The allegation in the Office Action that Martin fails to disclose the feature of a control code for use in comparing a control code sent by a remote control

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with a control code stored on the jukebox is entirely correct. Martin does not disclose these features because there is no requirement for a keyboard of the computer jukebox to have any such codes since the keyboard is not remote, it is part of the computer jukebox itself.

The Office Action then cites Cohen as remedying the admitted deficiencies of Martin. Cohen is inapplicable for numerous reasons. First, there is no teaching or suggestion in Cohen of providing control codes for a keyboard. Therefore, even if, *arguendo*, Cohen were properly combinable with Martin (which applicant respectfully submits is not the case), the combination fails to render the claims obvious. At best, the combination of Martin and Cohen would result in a keyboard having control codes. Moreover, the combination of Martin and Cohen would not result in the claimed remote control system having the specifically recited features set forth in the claims, because there is no teaching or suggestion in Cohen of these specifically recited features.

Second, there is no teaching or suggestion in either Martin or Cohen of providing a remote control for a jukebox. In particular, there is no motivation, absent improper hindsight, to combine the teachings of Cohen with those of the disparate and non-analogous reference to Martin to arrive at the claimed invention. The PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to

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combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This it has not done. The Office Action fails to cite prior art that remedies the deficiency of Martin or that suggests the obviousness of modifying Martin to achieve the claimed invention.

Instead, the Office Action improperly relies on hindsight reconstruction of the claimed invention by picking and choosing disparate teachings in the prior art in reaching its obviousness conclusion. "To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303, 312-313 (Fed. Cir. 1983). Here, there is no teaching or suggestion anywhere in Martin of a remote control as claimed. Moreover, there is no motivation in either Martin or Cohen of providing a remote control of the type claimed in for a jukebox system. Only the instant application provides any teaching of combining a remote control with a jukebox. As noted above, it is entirely improper to extract a motivation to combine disparate references using the teachings of the application itself. Thus, combining the non-analogous teachings of Martin and Cohen as proposed in the Office Action is entirely improper, and does *not* establish a *prima facie* case of obviousness.

In summary, there is no teaching or suggestion in either Martin or Cohen of the specifically claimed remote control and features attendant therewith. As such, the

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combination of Martin and Cohen fails to establish a *prima facie* case of obviousness.

Moreover, it is respectfully submitted that the combination of Martin and Cohen is entirely improper. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claim 14 under 35 U.S.C. §103(a) over Martin in view of Cohen, and further in view of Nathan et al. (U.S. Patent No. 6,182,126, hereinafter "Nathan") is respectfully traversed.

It is respectfully submitted that Nathan fails to overcome the fundamental deficiencies noted above with respect to the improper combination of Martin and Cohen. Therefore, even, *arguendo*, the proposed combination of references were proper, the combination nevertheless fails to render the claimed invention obvious. Additionally, the allegation in the Office Action that Nathan discloses or suggests a remote control device to activate and deactivate a payment device on the jukebox is simply incorrect and contrary to the specific teachings of Nathan. In particular, the buttons references by the Office Action are part of a touch screen user interface of the jukebox. As with the keyboard of Martin, the touch screen of Nathan is *not* a remote control and thus does not require the types of control codes claimed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing, it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited.

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Should the Examiner deem that further issues require resolution prior to allowance, the Examiner is invited to contact the undersigned attorney of record at the telephone number set forth below.

Respectfully submitted,

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